

Remarks

Claims 1-29 are currently pending in the patent application. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

In the Office Action dated February 25, 2008, the following rejections are present: claims 1-29 stand rejected under 35 U.S.C. § 112(1) and (2); and claims 1-3, 7, 11, 14-16, 18-19, 21-23 and 26-28 stand rejected under 35 U.S.C. § 103(a) over the Nakayama reference (U.S. Patent Pub. No. 2003/0134612) in view of the Ralph reference (U.S. Patent No. 5,640,699). The disclosure is objected to for informalities regarding subheadings, lack of correspondence with reference labels shown in the drawings, failure to provide antecedent basis for the claimed subject matter, and for grammatical informalities. Further, the drawings are objected to, and claims 3, 13, 18 and 23-24 are objected to due to for grammatical informalities.

Applicant respectfully traverses each of these objections and rejections, and requests that each be reconsidered and withdrawn in light of the following remarks.

Applicant disagrees with the Office Action's assessment that the specification is so "replete with terms which are not clear, concise, and exact" as to be noncompliant with 35 U.S.C. § 112(1). In accordance with M.P.E.P. § 2161.01, "[t]he function of the written description requirement is to ensure that the inventor had possession of, as of the filing date of the application relied on, the specific subject matter later claimed by him or her; how the specification accomplishes this is not material." The Office Action does not assert that the specification fails to demonstrate possession of the claimed invention. Rather, the Office Action opines that a few phrases should be rephrased for idiomatic or grammatical clarity. Applicant respectfully declines to amend the phrases called out in the Office Action, and submits that their meaning is sufficiently clear. Moreover, Applicant submits that the description in the specification is sufficiently clear to provide written description and enablement of the claimed invention, and requests that a proper evidentiary demonstration be made should the objection be maintained. Withdrawal of the objection is requested.

Applicant disagrees with the objection to the disclosure for lack of subheadings, for reference to claim 1 on page 2, and for allegedly vague terminology. Applicant

prefers not to add section headings for consistency with the parent application, and therefore respectfully declines to do so. Such section headings are not statutorily required, but per 37 CFR 1.51(d) are only guidelines that are suggested for an applicant's use. With respect to the reference to claim 1, Applicant is unaware of any prohibition in making statements in reference to "the subject matter recited in the claims" or "the subject matter of claim 1," particularly when summarizing the invention. With respect to the allegedly vague terminology in the specification, Applicant submits that each instance cited in the Office action would be sufficiently clear to one of skill in the art, and requests that evidentiary support to the contrary be given should the objection be maintained. Withdrawal of these objections is requested.

With respect to the objection to the specification for failure to refer to reference numbers provided in the drawings, Applicant submits that the present amendment sufficiently addresses the alleged deficiencies. Applicant further submits that indicia in the figures such as axis labels are understood on their own terms, and the references provided in the specification are fully adequate. Withdrawal of the objection is therefore requested.

With respect to the objection to the drawings for providing reference numbers not referred to in the specification, Applicant submits that the submission of replacement drawings herewith renders the objection moot.

Applicant traverses the objection to the drawings as allegedly failing to show features recited in claims 17 and 22. 37 C.F.R. § 1.81(a) states that a patent application should furnish drawings as necessary for the understanding of the subject matter sought to be patented. 37 C.F.R. § 1.83(a) further explains that the supplied drawings should show all the features specified in the claims. In this case, it has not been argued that Applicant has neglected to provide drawings, or that Applicant has failed to provide details that are necessary for the understanding of the invention, but rather that features recited in dependent claims 17 and 22 are not indicated. Applicant submits that features of claim 17 are shown, for example, in Fig. 2, and that the features recited in claim 22 are related to particular materials and do not lend themselves to specific pictorial indication. Applicant submits that such illustration is sufficient for understanding the claimed invention as

prescribed in M.P.E.P. § 608.02(e), and therefore requests reconsideration and withdrawal of the objection.

Applicant traverses the objection to the specification as allegedly failing to provide proper antecedent basis, and submits that each of the identified claim features are fully supported. The following lists the claim features identified in the Office Action along with examples of support from the specification:

as for claim 4, the thickness d being less than the width b , *see, e.g.*, page 4:5-8 and page 7:27-34;

as for claim 6, the dielectric constant of the layer surrounding the conductive tracks being greater than the dielectric constant of the surrounding dielectric layers *see, e.g.*, page 4:9-11;

as for the various dielectric compositions recited in claims 9 and 10, *see, e.g.*, page 4:9-20;

as for the working frequency of 400 MHz recited in claim 11, *see, e.g.*, page 5:27-29;

as for the value of k being larger by the specified value as recited in claims 12 and 13, *see, e.g.*, page 5:9-15;

as for the non-overlapping extension as recited in claim 17, *see, e.g.*, Fig. 2;

as for the conductive tracks surrounded by magnetic materials as recited in claim 22, *see, e.g.*, page 4:3-4; and

as for the impedance of the coupling being determined by the position of the conducting track structure as recited in claim 26, *see, e.g.*, page 6:13-15.

Applicant further submits that the original claims as filed are part of the patent specification. *See* 35 U.S.C. § 112(2); *In re Benno*, 768 F.2d 1340, 1346 (Fed.Cir.1985).

As such, in establishing a disclosure, an applicant may rely not only on the description and drawings as filed but also on the original claims if their content justifies it.

Therefore, and for the sake of added clarity, Applicant has also amended the specification to include the specific language originally recited in claims 12, 13 and 17. Applicant therefore requests reconsideration and withdrawal of the objection.

Applicant traverses the rejection of claims 1-29 under 35 U.S.C. § 112(1) as allegedly failing to comply with the enablement requirement. The Office Action states that there is inadequate written description to enable one of skill in the art to realize a resonator having different common-mode impedance and push-pull impedance. Applicant submits that the specification is fully enabling, and points to the following sections of the specification as examples of support: page 2:33 through page 3:2; page 3:19 through page 4:4; and page 4:11-12.

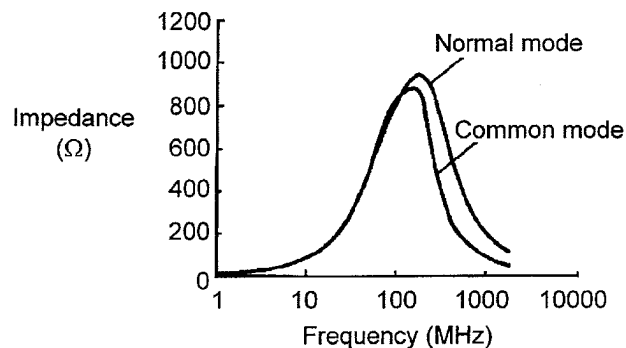
Applicant further submits that 35 U.S.C. § 112(1) contains three distinct and separate requirements, that of written description, enablement, and best mode. In accordance with M.P.E.P. § 2161, and the written description requirement and enablement requirement may each be satisfied without satisfying the other (*see, e.g., In re Armbruster*, 512 F.2d 676, 677 (CCPA 1975) stating, “[A] specification which 'describes' does not necessarily also 'enable' one skilled in the art to make or use the claimed invention.”). As such, Applicant submits that to the extent that the rejection is based on lack of enablement for insufficient written description, the rejection is improper.

For at least these reasons, Applicant requests reconsideration and withdrawal of the § 112(1) rejection of claims 1-29.

Applicant traverses the rejection of claims 1-29 under 35 U.S.C. § 112(2) as allegedly being indefinite. Without acquiescing, and for the purposes of expediting prosecution, Applicant submits that the present amendment sufficiently addresses each of the claim items delineated in the Office Action as being indefinite. Reconsideration and withdrawal of the § 112(2) rejection is therefore requested.

Applicant traverses the § 103(a) rejection of claims 1-3, 7, 11, 14-16, 18-19, 21-23 and 26-28 over Nakayama in view of Ralph. Applicant submits that the references are not properly combinable to produce Applicant's claimed invention in the manner suggested by the Examiner. The Office Action admits that Nakayama does not disclose adjusting the common-mode impedance and push-pull impedance (equated in the Office Action to Nakayama's normal mode impedance) to differ by a factor of at least 2. Applicant further submits that Nakayama explicitly discloses the normal and common mode impedances are similar in magnitude (*see* Fig. 3(a) of Nakayama).

FIG. 3(a)



Nakayama Fig. 3(a)

The stated purpose of Nakayama is to increase noise filtering by enhancing the impedance in both common mode and normal mode (*see, e.g.*, Nakayama paragraph 0035). As such, one of skill in the art would not understand Nakayama to suggest the desirability of increasing the difference between a common-mode impedance and push-pull impedance.

The Ralph reference apparently discloses large differences between odd-mode and even-mode impedances. The Office Action alleges that one of skill in the art would combine the teachings of Ralph with Nakayama to make the claimed invention. Applicant submits, however, that such a combination runs counter to the stated purposes of Nakayama, which are to enhance normal and common mode impedances, not to suppress one relative to the other. *See* MPEP § 2143.01; *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), stating that a §103 rejection cannot be maintained when the asserted modification undermines the purpose of the main reference. Applicant further submits that the present invention recognizes that the difference between common-mode impedance and push-pull impedance can be adjusted by adjusting the thicknesses and dielectric constants of the layers, whereas Ralph explicitly states that the impedance is controlled by the width, not the thickness, of the metal layers (Col. 1:67-2:4).

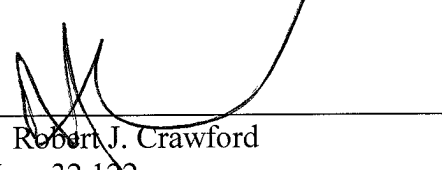
For at least these reasons, Applicant submits that the § 103(a) rejection of claims 1-3, 7, 11, 14-16, 18-19, 21-23 and 26-28 is improper and requests that it be reconsidered and withdrawn. Moreover, Applicant notes that no art rejection has been presented for

claims 4-6, 8-10, 12, 13, 17, 20, 24, 25 or 29. Applicant therefore requests indication of allowability of these claims even in the event that the § 103(a) rejection is maintained.

In view of the remarks above, Applicant believes that each of the rejections/objections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131
CUSTOMER NO. 65913

By: 
Name: Robert J. Crawford
Reg. No.: 32,122
(NXPS.490PA)

Attachment: Replacement Drawing Sheets-12 pages